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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,709	07/31/2003	Takashi Yokohari	520.42960X00	1601
24956	7590	09/22/2006	EXAMINER	
MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C. 1800 DIAGONAL ROAD SUITE 370 ALEXANDRIA, VA 22314			CHANNAVAJJALA, SRIRAMA T	
			ART UNIT	PAPER NUMBER
			2166	

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/630,709

Applicant(s)

YOKOHARI ET AL.

Examiner

Srirama Channavajjala

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 5-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 5-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Claims 1,3,5,6-9 are presented for examination.
2. Examiner acknowledges applicant's amendment filed on 7/6/2006.
3. Claims 1,3,5,6-9 have been amended [7/6/2006].
4. Claims 2,4 have been cancelled [7/6/2006].

Drawings

5. Examiner approved "proposed drawings fig 1-3,8", filed on 7/6/2006, a copy of the drawings fig 1-3,8 herewith enclosed with this office action, and replacement drawing sheets including the correction is required in response to this office action.
6. The Drawings filed on 7/31/2003 are acceptable for examination purpose

Priority

7. Acknowledgment is made of applicant's claim for foreign priority based on JP 2003-005208 filed on 14 Jan 2003 under 35 U.S.C. 119(a)-(d), the certified copy has been filed in the Application No. 10/630,709, filed on 7/31/2003.

Information Disclosure Statement

8. The information disclosure statement filed on 7/31/2003 is in compliance with the provisions of 37 CFR 1.97, and has been considered [Abstract in English only] and a copy is enclosed with this Office Action.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. *Claims 1,3,5-9 are rejected under 35 U.S.C. 101 because invention is directed to non-statutory subject matter.*

As set forth in MPEP 2106(II)A:

Identify and understand Any Practical Application Asserted for the Invention The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373, 47USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); In re Ziegler, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant

believes the claimed invention is useful.

Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See Arrhythmia, 958 F.2d at 1057, 22 USPQ2d at 1036.

Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

10. Regarding claim 1,6, "A job guidance and assistance system for guiding and assisting a job of producing a document, comprising:

 'a referring record database; a referring record searcher; a document production record searcher; a similarity estimator; and a computer, wherein the computer is programmed to: store in the referring record database a relationship formed between a document to be produced and a reference material, which is referred to for producing the document;

 search for the relationship between the document to be produced and the reference material, which is stored in the referring record database, by using the referring record searcher;

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search for a reference relationship between the document and the reference material, by using the document production record searcher; and

form the relationship, by using the similarity estimator, wherein the relationship is based on a comparison of at least one word appearing in the document to be produced and the reference document, a comparison of categories of the document to be produced and the reference document, and a comparison of a referring time or a referring frequency of the document to be produced and the reference document” is directed to “abstract idea” because all of the elements in the claim 1,6 would reasonably be interpreted by one of ordinary skill in light of the disclosure at page 7-11, page 14, line 14-29, page 15, line 12-33, page 1617 as software, such that the method is software, per se, is “non-statutory subject matter” and **claim 1,6** do not have “practical application” because the “final result” by the claimed invention in the claim 1,6 elements particularly “search for the relationship between the document to be produced and the reference material, which is stored in the referring record database, by using the referring record searcher;

search for a reference relationship between the document and the reference material, by using the document production record searcher; and

form the relationship, by using the similarity estimator, wherein the relationship is based on a comparison of at least one word appearing in the document to be produced and the reference document, a comparison of categories of the document to be produced and the reference document, and a comparison of a referring time or a referring frequency of the document to be produced and the reference document” is

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merely searching reference relationship between documents and document production record searcher and comparison of categories of the documents and related attributes but not producing “useful, tangible and concrete” result, furthermore, it appears to be computer “algorithm” or software routines therefore, claim 1,6 is a non-statutory subject matter. The claimed invention is subject to the test of State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. Specifically State Street sets forth that the claimed invention must produce a ***“useful, concrete and tangible result.”*** The **Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility** states in section IV C. 2 b. (2) (on page 21 in the PDF format):

The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had “no substantial practical application.”).

[If] Claim 1,6 have the result of producing “real-world” results related search for a reference relationship between the document and the reference material, by using the document production record searcher; and form the relationship, by using the similarity estimator, wherein the relationship is based on a comparison of at least one word appearing in the document to be produced and the reference document, a comparison of categories of the document to be produced and the reference document, and a

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comparison of a referring time or a referring frequency of the document to be produced and the reference document”, however the claim[s] do not specify that the real world result neither output, displayed or at least stored

The claims 3,5,7-9 dependent from claim 1,6 are also rejected in the above analysis.

For “General Analysis for Determining Patent-Eligible Subject Matter”, see 101 Interim Guidelines as indicated below:

<<<http://www.uspto.gov/web/offices/pac/dapp/ogsheet.html>>>

No new matter should be entered

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. ***Claims 1,3,5-9 are rejected under 35 U.S.C. 102(e) as being anticipated by***

Grefenstette et al. [hereafter Grefenstette], US Publication No. 2003/0069877 filed on

Dec 5, 2001 and published on April 10,2003

13. As to claim 1,6, Grefenstette teaches a system which including “a job guidance and assistance system for guiding and assisting a job of producing a document’

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[page 1, col 2, 0013, page 2, col 2, 0013], Grefenstette is directed to document classification, labeling classification, overall organizing classification of the documents for retrieval purposes as detailed in page 1-2, 0013]

'a referring record database [fig 4, element 101]; a referring record searcher [fig 4, element 410]; 'a document production record searcher' [fig 4, element 416,420; 'a similarity estimator; and a computer' [page 14, col 2, 0254, page 15, col 1, 0260, fig 21], a similarity estimator corresponds to similarity measurement particularly documents as detailed in fig 21, page 14, 0254, page 15, 0260; 'wherein the computer is programmed to: store in the referring record database a relationship formed between a document to be produced and a reference material, which is referred to for producing the document' [fig 23, page 15, col 1, 0261], Grefenstette specifically teaches establishing relationship entity database and entity statistics particularly, similarity measurement between entity and contextual information related to documents as detailed in page 15, 0261] ;

search for the relationship between the document to be produced and the reference material, which is stored in the referring record database, by using the referring record searcher' [page 16, col 2, 0276, 0278], Grefenstette specifically teaches information extraction technique that including meta-document server that identifying document content referenced by hyperlinks as detailed in page 16, col 2, 0276 that corresponds to relationship between the document and the reference material and various examples have been provided for example building code, zoning laws, property evaluations and like [see 0276];;

search for a reference relationship between the document and the reference material, by using the document production record searcher' [page 16, 0275-0276]; Grefenstette specifically suggests reference relationship between various documents particularly in the meta-document server along with document content referenced by the hyperlinks for example as detailed in fig 15;

form the relationship, by using the similarity estimator [page 16, col 1, 0268], Grefenstette specifically suggests measuring similarity relationship as detailed in page 16, 0268;, 'wherein the relationship is based on a comparison of at least one word appearing in the document to be produced and the reference document [page 30, col 1, 0447, col 2, 0450], Grefenstette specifically suggests meta-document server analyze document's words for example entities can be strings from a list or proper name, 'a comparison of categories of the document to be produced and the reference document' [page 34, col 1, 0491], Grefenstette specifically suggests comparing or matching string fragment and entries of categories and identifies one or more matches as detailed in page 34, col 1, 0491; 'and a comparison of a referring time or a referring frequency of the document to be produced and the reference document" [page 30, col 2, 0448, 0449], Grefenstette specifically suggests update period for each entity that references to document servers particularly entity-specific information.

14. As to claim 3, Grefenstette disclosed 'means for displaying the relationship' [fig 35, page 23, col 1, 0351].

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15. As to claim 5, Grefenstette disclosed 'similarity estimator estimates that the reference material is opened, if the reference material is opened when the document to be produced is opened' [page 13, col 2, 0242-0243].

16. As to claim 7, Grefenstette disclosed 'wherein the relationship is searchable when producing a new document or renewing an existing document, based on the relationship formed' [page 28, col 1, 0415].

17. As to claim 8, Grefenstette disclosed 'wherein relationship based on the at least one word appearing is executed with using a plural number of words, in an order starting from a word, which appears in the document to be produced, at the least' [page 19, 0302, 0305].

18. As to claim 9, Grefenstette disclosed 'wherein similarity estimator, said referring record searcher, and said document production record searcher software programs implemented by the computer' [page 14, col 2, 0254].

Response to Arguments

Applicant's arguments filed on 7/6/2006 with respect to claims 1,3,5-9 have been fully considered but they are not persuasive, for examiner's response, see discussion below:

a) At page 9-10, regarding 35 USC 101 rejections, applicant argues that claims 1,3,5-9 directed to a system comprising hardware (a computer) that implements the features of the claimed invention.

As to the above argument [b], claims 1,6 are directed to "abstract idea" because all of the elements in the claim 1,6 would reasonably be interpreted by one of ordinary skill in light of the disclosure at page 7-11, page 14, line 14-29, page 15, line 12-33, page 1617 as software, such that the method is software, per se, is "non-statutory subject matter", furthermore, merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting [see MPEP 2106. As noted in the above office action "final result" by the claimed invention in the claim 1,6 elements particularly "search for the relationship between the document to be produced and the reference material, which is stored in the referring record database, by using the referring record searcher;

search for a reference relationship between the document and the reference material, by using the document production record searcher; and form the relationship, by using the similarity estimator, wherein the relationship is based on a comparison of at least one word appearing in the document to be produced and

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the reference document, a comparison of categories of the document to be produced and the reference document, and a comparison of a referring time or a referring frequency of the document to be produced and the reference document” is merely searching reference relationship between documents and document production record searcher and comparison of categories of the documents and related attributes but not producing **“useful, tangible and concrete”** result, furthermore, it appears to be computer “algorithm” or software routines therefore, claim 1,6 is a non-statutory subject matter.

Examiner applies above arguments to dependent claims 3,5,9,7-8.

b) At page 12-13, claim 1,6, applicant argues that Grefenstette does not disclose “form the relationship, by using the similarity estimator, wherein the relationship is based on a comparison of at least one word appearing in the document to be produced and the reference document, a comparison of categories of the document to be produced and the reference document, and a comparison of a referring time or a referring frequency of the document to be produced and the reference document “

As to the above limitation, as best understood by the examiner, Grefenstette is directed to document management, more specifically organizing document classification, each class in the classification associated with classification label that corresponding to the categories and like [page 1, col 2, 0013]. Also, it is noted that Grefenstette teaches meta-document server analyze document's words for example entities can be strings from a list or proper name [see page 30, 0447, 0450], also

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comparing or matching string fragment and entries of categories and identifies one or more matches that corresponds to comparison of categories.....reference document [see page 34, 0491], further update period for each entity that references to document, particularly entity-specific information that corresponds to 'comparison of a referring time or a referring frequency of the document to be produced and the reference document [page 30, 0448, 0449].

Therefore, applicant's remarks are deemed not to be persuasive, and claims 1,3,5-9 stand rejected under 35 USC 102(e) as being clearly anticipated by Grefenstette et al.

Conclusion

The prior art made of record

US Pub. No. 20030069877


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Srirama Channavajjala whose telephone number is 571-272-4108. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alam, Hosain, T, can be reached on (571) 272-3978. The fax phone numbers for the organization where the application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)

SC
Patent Examiner.
September 18, 2006


SRIRAMA CHANNAVAJALA
PRIMARY EXAMINER



Approved
9/18/06

FIG.1

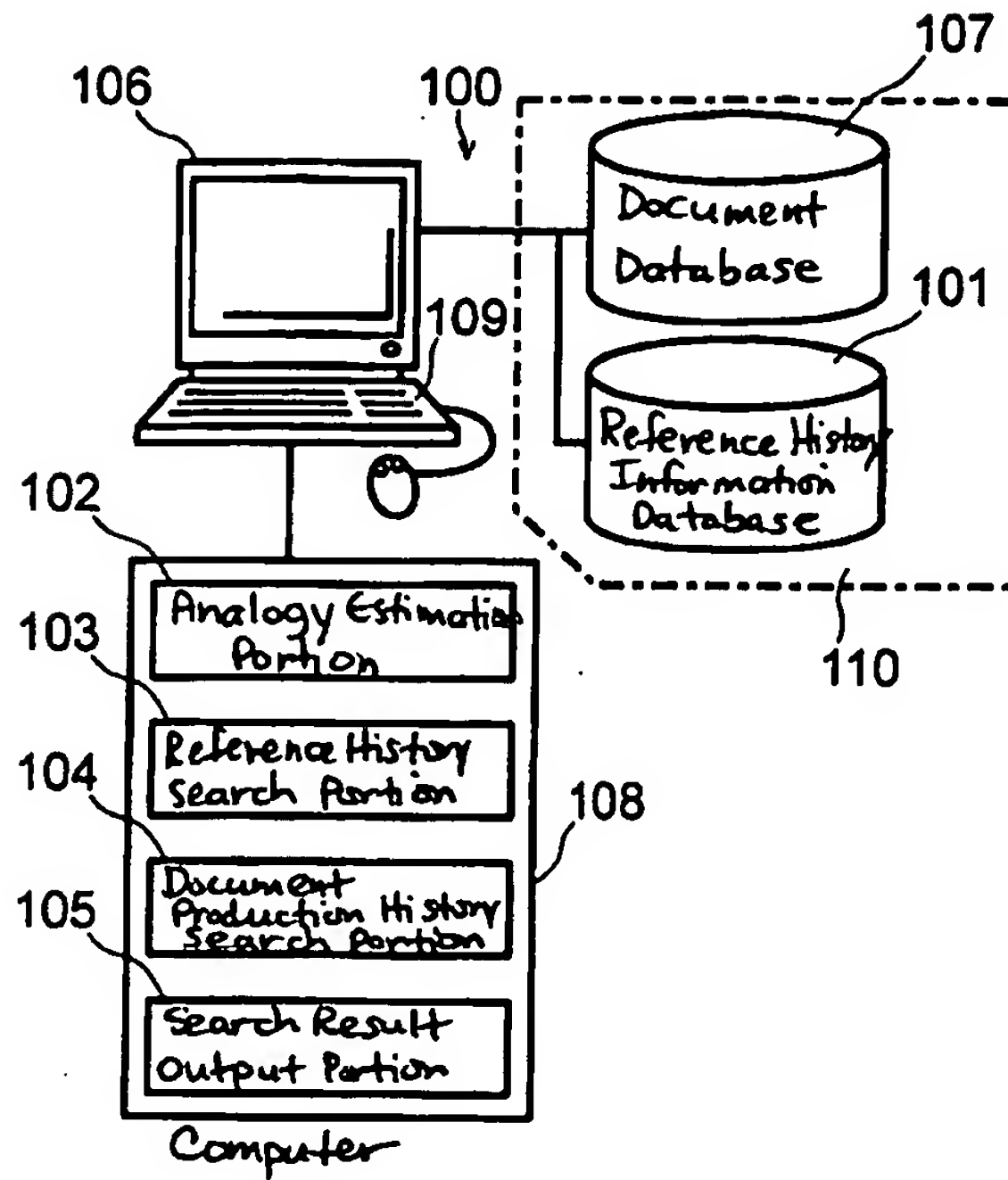
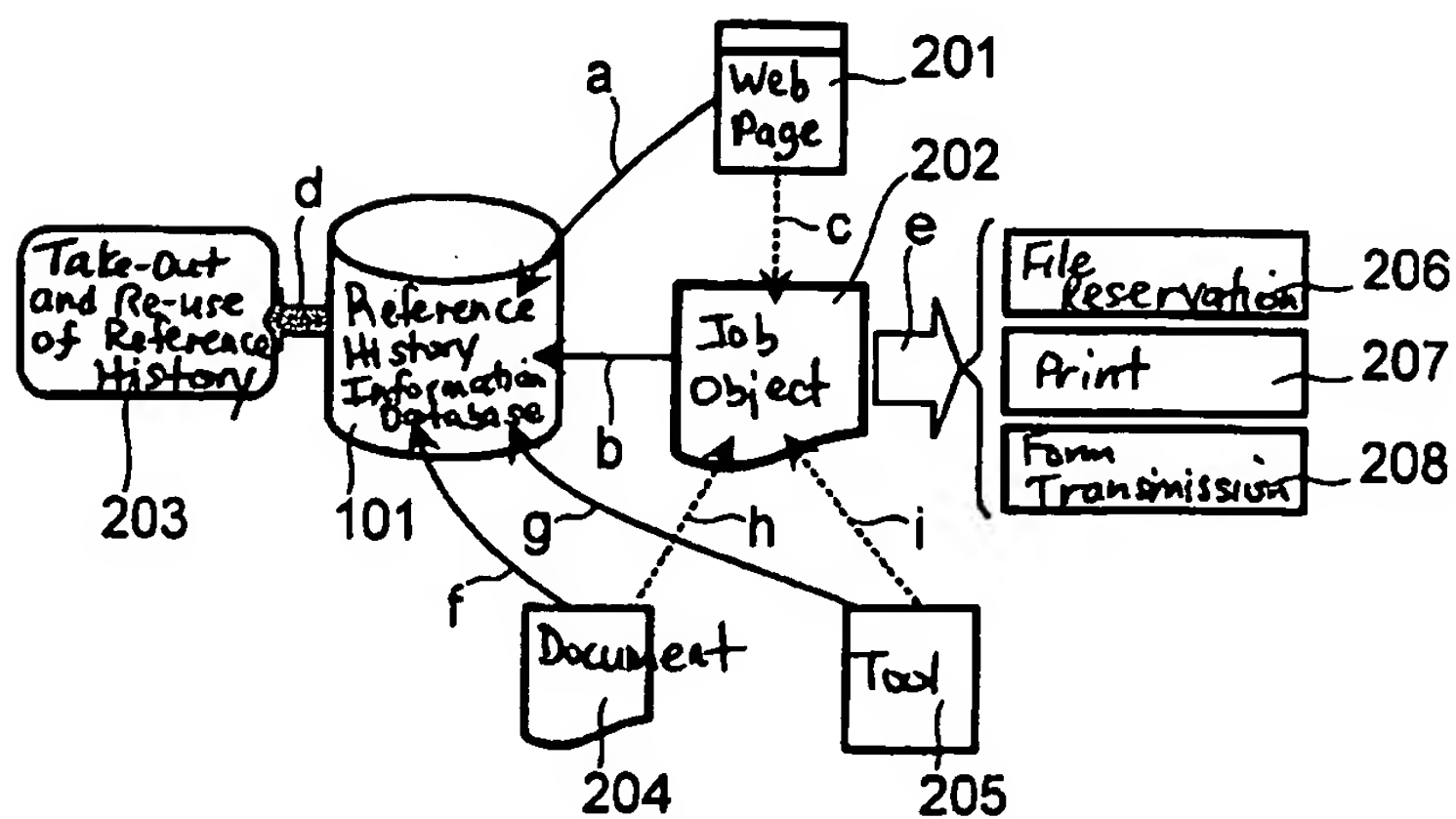


FIG.2





Approved
9/18/2006

FIG.3

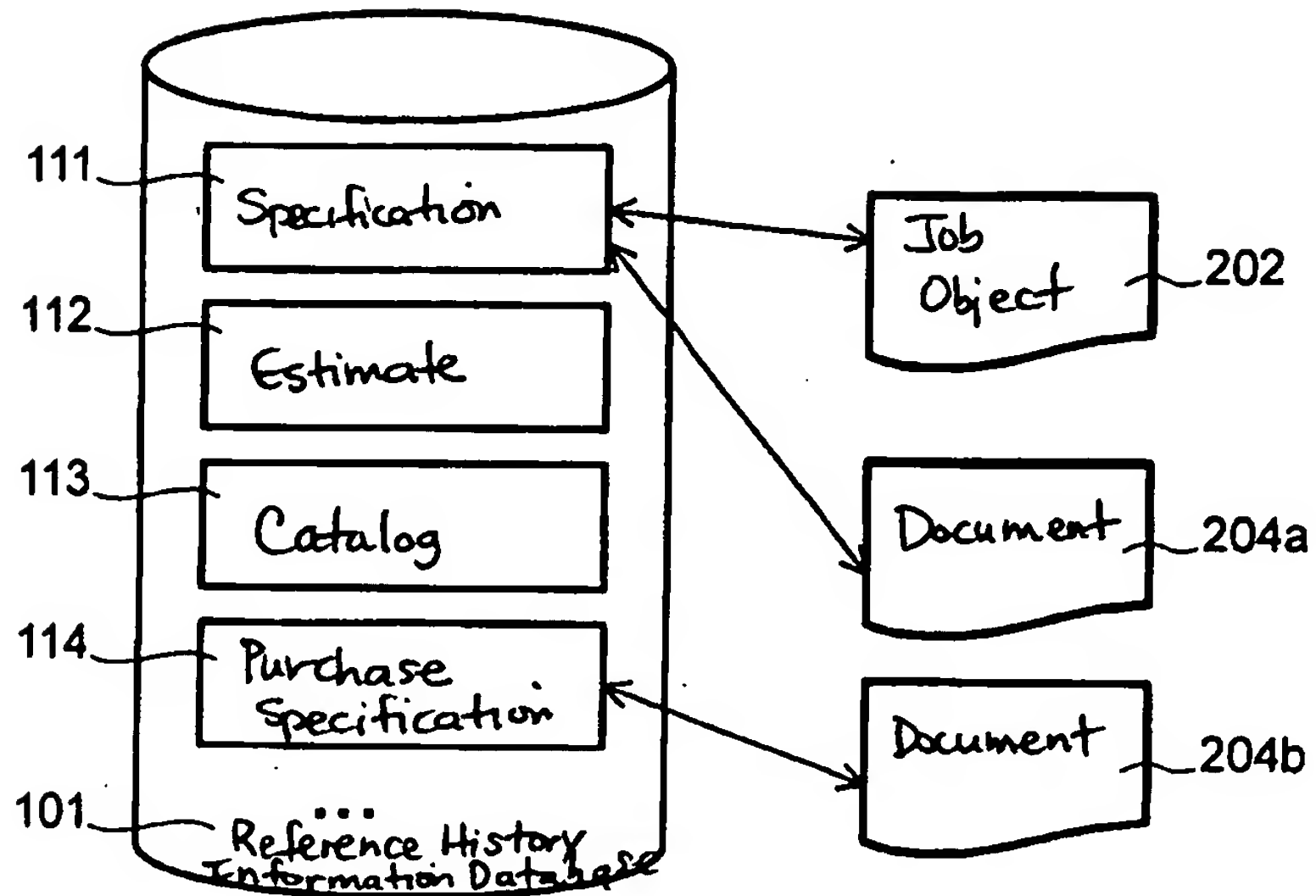
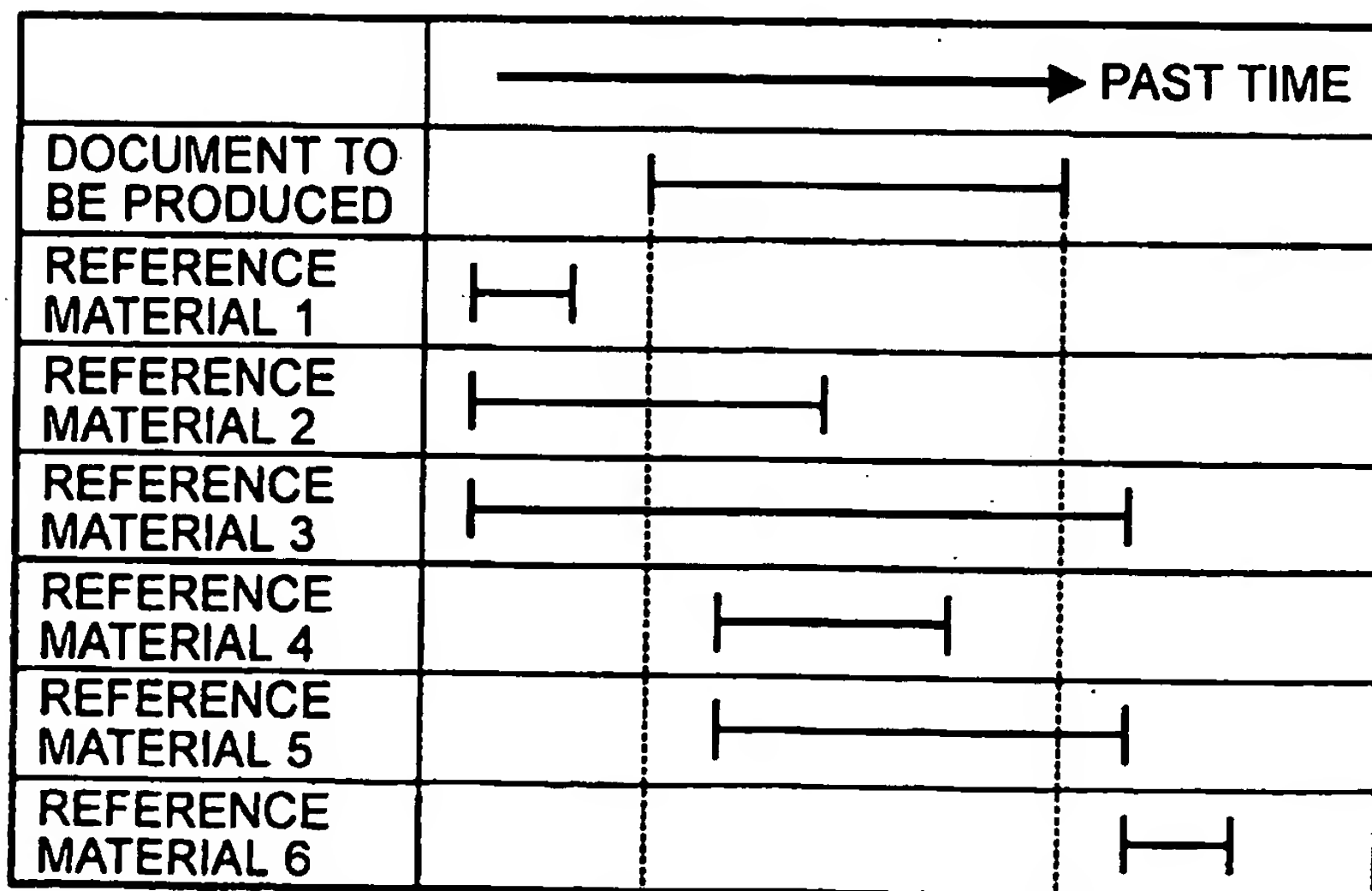


FIG.4





Approved
9/18/2005

FIG.8

